

REMARKS:

Applicants submit the following amendments and remarks in response to the Office Action mailed April 30, 2008. A one-month extension of time extending the period of reply from July 30, 2008 up to and including September 2, 2008 is submitted herewith.

Claims 1-13 were rejected in the Action. Claims 1 and 12 have been amended, claim 6 has been cancelled, and claims 14 and 15 have been added herein. Therefore, claims 1-5 and 7-15 are now pending in the present application. Support for all claim amendments and new claims can be found in Applicants' originally filed specification and drawings. As such, no new matter has been added. Applicants set forth remarks relating to the Office Action below.

In the Action, the Examiner noted that an application in which the benefits of an earlier application are desired must contain a specific reference to the prior applications in the first sentence of the specification. The above-noted revisions to paragraph [0001] of the specification, an Application Data Sheet and a Letter to Correct Filing Receipt are respectfully submitted by Applicants to correct the priority of the present case.

Further in the Action, the Examiner rejected previously presented claims 1-5, and 7 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Pub. No. 2001/0020170 to Zucherman *et al.* ("Zucherman"). Applicants respectfully submit amended independent claim 1 is not anticipated by Zucherman because the cited reference does not disclose or suggest, among other limitations, an apparatus including "at least one shaft having a distal end and a longitudinal axis, the distal end of the at least one shaft bending in a direction toward one of the

group consisting of left and right relative to the longitudinal axis of the shaft." By the Examiner's own admission, the recitation of the at least one shaft bending in a direction toward one of the group consisting of left and right relative to the longitudinal axis of the shaft previously presented in canceled claim 6 is not disclosed or suggested in *Zucherman*.

However, the Examiner rejected previously presented claim 6 under 35 U.S.C. 103(a) as being unpatentable over *Zucherman*. The Examiner asserted that while *Zucherman* fails to show a curved distal end of the shaft, it would have been obvious for one of ordinary skill in the art to modify the distal end of the shaft since such a change only involves routine skill in the art. The Examiner notes that such a routine skill would accommodate a different shaped spacer.

Applicants respectfully disagree and traverse. Paragraph [0130] of the originally filed specification states that "the direction of the prongs, and the location of the pins relative to the central shaft, determine the angle or angles of surgical approach for which a particular repositioner/extractor can be used." Therefore, Applicants disagree that such a configuration only involves routine skill in the art since the specification of the present application has outlined reasons for such a configuration and the Examiner has not pointed to a single reference that discloses such a configuration. Further, such a configuration imparts structure on the claim which differentiates from anything disclosed or suggested in *Zucherman*. Therefore, amended independent claim 1 is neither anticipated nor obviated by *Zucherman* and is in condition for allowance. Claims 2-5, 7-11, and 14-15 are neither anticipated nor obviated by *Zucherman*, *inter alia*, by virtue of their dependence from independent claim 1, or an intervening claim. A

dependent claim is necessarily narrower than an independent claim from which it properly depends.

Further in the Action, the Examiner rejected previously presented claims 1, 2, and 8-13 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. No. 20030125739 to Bagga *et al.* ("*Bagga*") in view of U.S. Patent Pub. No. 20030028249 to Baccelli *et al.* ("*Baccelli*"). The Examiner asserted that *Bagga* shows a spacer with side recesses and holes and additionally illustrates a tool for insertion of the implant with prongs at the distal end of the shaft and one set of prongs perpendicular from the shaft. However, the Examiner noted that *Bagga* does not disclose pins on the prongs for engagement with the holes. The Examiner cited *Baccelli* as teaching a tool with a pin to engage a recess, and asserted it would have obvious to one of ordinary skill in the art at the time of the present invention to use pins as taught by *Baccelli* with the tool of *Bagga* such that it provides a better means to interlock the tool and implant to prevent separation during insertion.

Applicants respectfully submit amended independent claim 1 (which includes the limitations of cancelled claim 6) is not obviated by *Bagga* in view of *Baccelli* because the cited references do not teach or suggest, among other limitations, an apparatus including "at least one shaft having a distal end and a longitudinal axis, the distal end of the at least one shaft bending in a direction toward one of the group consisting of left and right relative to the longitudinal axis of the shaft." As described above, this limitation is not disclosed or suggested in *Zucherman*. Further, neither *Bagga* nor *Baccelli* teach the required structure. Therefore, a *prima facie* case of obviousness cannot be made with respect to amended claim 1 in view of the cited references. Applicants respectfully assert

claim 1 and claims 2-5, 7-11, and 14-15 depending therefrom are therefore allowable.

Further, Applicants respectfully submit independent claim 12 is unobvious and therefore allowable in view of *Bagga* and *Baccelli*. The above outlined assertions by the Examiner mischaracterize these cited references. Firstly, *Bagga* does not illustrate a tool for insertion of the implant disclosed therein having prongs at the distal end of a shaft wherein one set of prongs is perpendicular to the shaft as asserted by the Examiner. Further, neither *Bagga* nor *Baccelli* disclose or suggest a distal end of a shaft having a first prong and a second prong, the "the first prong extending along the longitudinal axis of the shaft and the second prong being curved and extending away from the longitudinal axis" as required by amended claim 12. Therefore, a *prima facie* case of obviousness cannot be made with respect to claim 12 in view of the cited references. Applicants respectfully assert claim 12 and claim 13 depending therefrom are therefore allowable.

Further in the Action, the Examiner rejected claims 1, 2, 4, 5, and 12 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 12 and 13 of U.S. Patent No. 7,223,291 to Errico *et al.* ("*Errico*"). Regardless of whether Applicants agree or disagree with the present non-statutory obviousness-type double patenting rejections of claims 1, 2, 4, 5, and 12, for the purpose of expediting the allowance of the claims in the present Application, Applicants have prepared the enclosed Terminal Disclaimer to overcome the '291 patent. Applicants note that the present Application and the '291 patent are assigned to a common assignee SpineCore, Inc.

Application No.: 10/784,598

Docket No.: SPINE 3.0-437
CIPCIPCIPCIPCIPCIPCON III

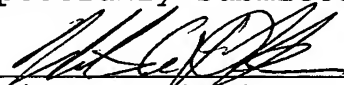
As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: September 2, 2008

Respectfully submitted,

By 
William A. Di Bianca
Registration No.: 58,653
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicants